

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

By this Amendment, new claims 22 and 23 are added to secure an appropriate scope of protection to which Applicants are believed entitled. No new matter is presented in this Amendment. Support for the added claims is believed to be found at in least page 3, lines 33 to 39, and Fig. 1 of the present specification. Accordingly, claims 1-6, 11-16, and 22-23 are pending in this application.

The Patent and Trademark Office (PTO) rejects claims 1-6 and 11-16 under 35 USC 112, first paragraph, alleging that the specification does not reasonably provide enablement for any electrically operated components capable of being included in an electric hand tool.

Applicants appreciate the indications made by Examiner Wills during the telephonic interview held April 10, 2009 that adding dependent claims 22 and 23 to more clearly recite the claimed subject matter would be persuasive in overcoming the 112 claim rejections. Accordingly, new claims 22 and 23 are added, reciting wherein the electrically operated components of the electric hand tool includes an electric motor. Based upon new claims 22 and 23 and the remarks below, the rejection of claims 1-6 and 11-16 is respectfully traversed.

New claims 22 and 23 depend from claims 1 and 11, respectively, and find support in at least page 3, line 33 to page 4, line 1 of the instant specification that discloses wherein "[t]he tool depicted in the figure in this instance is a hammer drill intended to strike a drill bit, also driven in terms of rotation in support material, via a piston propelled in a cylinder, along an axis 1, under the action of an electric motor powered by a battery 3 arranged in an accommodating housing 4 formed in a leg 5, running roughly orthogonal to the axis 1 and connected to the casing 2."

Notwithstanding the addition of new claims 22 and 23, Applicants believe that the PTO has failed to meet the burden of presenting why a person of ordinary skill in the art would not recognize in Applicants' disclosure a description of the invention defined by the claims. Applicants respectfully submit that there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed, and that the PTO has the initial burden of

presenting by a preponderance of evidence why a person skilled in the art would not recognize in Applicants' disclosure a description of the invention defined by the claims. (*In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims").

In view of the foregoing, Applicants respectfully submit that all claims fully comply with 35 U.S.C. §112, first paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion


All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

The Examiner is invited to telephone the undersigned, Applicants' attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: April 15, 2009
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